

**REMARKS**

The Office Action of July 8, 2009 presents the examination of claims 1-22. Claims 1, 2, 7, 9-14 and 20-22 are amended, and claims 4-5 and 15-19 are canceled.

The amendment of claim 2 to recite the various substituents II is supported by the text of the specification at page 24, lines 1-10. The recitation of "carbamoyl" as a substituent is supported by original claim 2 and at page 196, line 19 of the specification.

The specification is amended to correct a typographical error readily apparent from the text and to correct the abstract in the manner requested by the Examiner. The structures of formulae indicated by numbers only are added for clarity.

No new matter is added by any amendment herein.

Election/Restriction

The Examiner objects to claim 19 as being an improper Markush group. Claim 19 has been canceled; Applicants reserve the right to pursue subject matter canceled from this application pursuant to 35 USC § 120.

Rejections for anticipation

Claims 1-21 are rejected under 35 USC § 102(a) as being anticipated by WO 2004/029054. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants provide attached hereto a verified English translation of the priority document. Applicants submit that the amended, now pending claims 1-3, 6-14, 20 and 21 are novel over the reference and request that this rejection be withdrawn.

Rejection under 35 USC § 101

Claims 15-17 are rejected under 35 USC § 101 as being improper "use" claims. Claims 15-17 have been canceled, rendering this rejection moot.

Rejection under 35 USC § 112, first paragraph

Claims 19 and 20 are rejected under 35 USC § 112, first paragraph, for alleged lack of enablement by the specification. In particular, the Examiner argues that the full scope of treatment of many diseases using "trillions" of compounds is not enabled.

Although Applicants do not agree with the Examiner's position, claim 19 has been canceled rendering its rejection moot. Claim 20 is directed to a process for making the compounds of claim 1, and this has not been addressed by the Examiner's reasoning in the Office Action. Applicants therefore suppose that claim 20 was not actually intended to be included in this rejection. Withdrawal of this rejection of claim 20 is requested.

Objections to the specification and claims

The Abstract has been amended to correct the spelling of "diseases" as requested.

Claim 21 has been amended to independent form.

Applicants submit that the pending claims clearly recite subject matter patentable over the prior art of record. The favorable actions of withdrawal of the standing rejections and allowance of the present claims are requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell (Reg. No. 36,623 ) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

A petition for extension of the period for response for three (3) months, to January 8, 2010 is appended hereto.

Rejection for obviousness

Claim 22 is rejected under 35 USC § 103(a) as being unpatentable over WO 2004/029054. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

The particular compounds recited in claim 22 are specifically described in the priority application, or can be readily visualized by the skilled artisan who reads its disclosure. Thus, the instant rejection is overcome by filing of the English translation of the priority document.

Rejection for obviousness-type double patenting

Claims 1-22 are **provisionally** rejected under the doctrine of obviousness-type double patenting over claims 89-108 and 110-132 of copending application 10528343.

Applicants note the provisional nature of this rejection and request that it be held in abeyance until allowable subject matter is found in either of this or the '343 application, at which time the issue will be addressed substantially.

Rejections under 35 USC § 112, second paragraph

Claims 1-22 are rejected under 35 USC § 112, second paragraph for a number of reasons as set forth at pp. 8-9 of the Office Action.

1. Claim 2 is rejected on the basis that the "C<sub>2-10</sub> acyloxy" group in claim 2 is unclear. The Specification defines the term at page 21, lines 12-19, and so it is not at all unclear.
2. "Acycloalkyl" in claim 2 is a mistranslation. This has been deleted from the claim.
3. Composition claims 11-14 have been amended to recite a carrier as recommended by the Examiner.
4. "Cyclic amino" is not actually recited in any claim.
5. "Use" claims 15-17 have been canceled.
6. "Swiss-type" claims 16-17 have been canceled.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: January 6, 2010

Respectfully submitted,

By 

Mark J. Nuell

Registration No.: 36,623

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant